

## Non-Fee Amendment

Applicant Docket No. 19001.1300

## REMARKS

The Patent Office has set forth grounds for rejecting claims 1-16. The applicant submits that the claims as currently presented are allowable in view of the art cited by the Patent Office and respectfully request the Patent Office remove the present rejection from these claims. The applicant's traversals, either through argument or amendment, of the Patent Office's rejections are provided below.

Rejection Under 35 U.S.C. §112

The Patent Office has indicated that claim 14 includes the term "the ordering routine". Since claim 14 depends directly from claim 1 and claim 1 does not currently define this term, the Patent Office has rejected claim 14. The Patent Office's rejection has been reviewed and addressed by providing an amendment to claim 14 to correct the lack of antecedent for the element of the ordering routine.

Claims 1-6, 8, 10-13, 15 and 16 Are Patentable Over the Cited Art

The Official Action sets forth rejections for claims 1-6, 8, 10-13, 15 and 16 under 35 U.S.C. §103(a) alleging that the claims are unpatentable over U.S. Patent No. 6,523,037 B1 to *Monahan et al.* The Official Action actually sets forth the exact same arguments that were presented in the February 23, 2004 Official Action and that were fully addressed in the applicant's response. Thus, the applicant respectfully maintains disagreement with the Patent Office's allegation. The applicant will present his arguments more clearly in this response.

In general, the present invention provides an interactive electronic commercial which is sent to a recipient via e-mail. The interactive electronic commercial includes a branding graphic

**Non-Fee Amendment**

Applicant Docket No. 19001.1300

integrated with an interface portion through which the recipient may conduct an additional search. The Patent Office admits that *Monahan et al.* does not teach of a branding graphic in conjunction with an interface portion that receives a search string. The recipient of the interactive electronic commercial may then designate a search string. This search string is then processed by a search engine that is interfaced to by the e-mail, and the search results are then relayed back to the recipient within the e-mail, without the use of a browser. Thus, the entire process is conducted within the e-mail that conveys the interactive electronic commercial to the recipient.

More specifically, claim 1 recites:

interactive electronic commercial; and

an e-mail used to convey the interactive electronic commercial to a recipient.

The applicant respectfully submits that *Monahan et al.* does not describe, suggest or teach this element and the office has not provided any basis establishing this as an obvious element. As recited, an e-mail conveys the interactive electronic commercial to a recipient. *Monahan et al.* teaches a user initiating a search request by communication to a web site using an HTTP PUT request. Col. 5, lines 19-30. The search results may then be communicated back to the user or to another user through various means, one such means including an email message. However, this is not the same as the claimed invention that is initiated by the user receiving the e-mail containing the interactive electronic commercial. The applicant fails to find any mention in the cited reference of an e-mail message that includes an interactive electronic commercial and, an electronic commercial that includes an interface for receiving search request information,

**Non-Fee Amendment**

Applicant Docket No. 19001.1300

obtaining search results based on the search information and providing the results within the same email message.

Claims 2-6, 8, 10-13 depend either directly or indirectly from claim 1. Thus, since claim 1 is in condition for allowance, the dependent claims are also in condition for allowance as they include the limitations of the corresponding base claim.

For the same arguments presented for claim 1, claims 15 and 16 are also in condition for allowance.

The applicant greatly appreciates the Office's careful consideration of these amendments and remarks. The applicant has thoroughly reviewed the references provided by the Office and has shown how the present invention is patentable over these references. Therefore, the applicant respectfully requests the Office to move this case towards allowance.

**Claims 7, 9 and 14 Are Patentable Over the Cited Art**

The Patent Office set forth rejections for claims 7, 9 and 14 under 35 USC §103(a) alleging that the claims are unpatentable over U.S. Patent No. 6,523,037 to *Monahan et al.* in view of U.S. Patent No. 6,101,485 to *Fortenberry et al.* The Patent Office further alleges that it would have been obvious to modify the teachings of *Monahan et al.* to include *Fortenberry et al.* in order to include the ability to order products from within an e-mail message as taught by *Fortenberry et al.*

*Fortenberry et al.* describes allowing a shopper to fill out and submit an order, directly from an e-mail solicitation. However, *Monahan et al.* and *Fortenberry et al.* do not teach of e-

**Non-Fee Amendment**

Applicant Docket No. 19001.1300

mails which contain a branding graphic integrated with an interface portion through which the recipient may conduct an additional search. Thus, combining the two references would only result in a means for a shopper to conduct orders by first narrowing the choices and then placing an actual order directly from the e-mail. There is no integrated search capability within the e-mail client and it would not have been obvious to add this element to the combination of *Monahan et al.* and *Fortenberry et al.* Therefore, the applicant respectfully submits that claims 7, 9 and 14 are allowable over the cited art. Furthermore, claims 7, 9 and 14 depend either directly or indirectly from claim 1 and thus are also in condition for allowance.

In addition, claims 7, 9 and 14 each depend directly or indirectly from claim 1, which is now in condition for allowance.

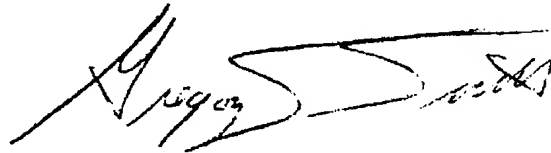
**Non-Fee Amendment**

Applicant Docket No. 19001.1300

**CONCLUSION**

Applicant respectfully submits the claims 1-16 are allowable over the cited art and respectfully request the Patent Office to move this case towards allowance. The applicant invites the Patent Office to contact the undersigned at its convenience should the Patent Office believe it would facilitate prosecution of this application. Applicant thanks the Examiner for consideration of this application.

Respectfully submitted,



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